

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the reasons that follow.

Claims 2-10, 12-17, and 21-24 are currently pending in this application.

Claim 21 is requested to be amended. No new matter is added.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claim Rejections – 35 U.S.C. §103(a)

a. Rejection of claim 6 based on Ko in view of Hess.

In Section 4 of the Office Action, claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ko (U.S. Published Patent Application No. 2005/0049011) in view of Hess (U.S. Patent No. 5,777,551).

As an initial matter, Applicants note that while Ko claims priority to a U.S. application filed on April 25, 2001 and a foreign application dated October 31, 2000, Ko is not entitled to this foreign priority date as a prior art reference for purposes of 35 U.S.C. § 103(a)/102(e). See Manual of Patent Examining Procedure § 706.02(f)(1). Accordingly, Applicants do not waive any rights to take any action which would be appropriate to antedate Ko based on the April 25, 2001 effective filing date of Ko. Applicants remarks with regard to Ko below are not intended as an admission that Ko constitutes prior art.

To establish prima facie obviousness of a claimed invention under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art (see M.P.E.P. § 2143.03). The Applicants respectfully submit that the Office Action fails to establish a prima facie case of obviousness with respect to claim 6 because the combination of Ko and Hess fails to teach or

suggest “wherein the device is programmed to effectuate a predetermined communications connection when a user depresses two or more input keys simultaneously and the device effectuates the predetermined communications connection when the wireless telephony device is either powered on or off” as recited in the combination of elements of claim 6.

The Office Action states that “Ko discloses ... a plurality of input keys (i.e., keypad) (page 1[0012], wherein the device is allows a user to depress input keys when the wireless telephony device is either powered on or off (see page 3 [0039]). Applicants respectfully submit, however, that Ko discloses in paragraph [0012] that the keypad has a “power key,” and that the apparatus also has “an external function key which can by key input by a user even if the sub body is closed onto the main body.” Ko discloses in paragraph [0027] (emphasis added) that:

[T]he user can power on/off the terminal by using either the automatic folder switch 180 arranged in the side of the main body 110 or the power key 190 in the key pad on the main body 110 Therefore, the user can power on/off the terminal without opening the sub-body 120. Also, when the terminal is powered on, the automatic folder switch 180 or the power key 190 can perform their own characteristic key functions.

Ko further states in paragraph [0034] with reference to the circuit diagrams of FIGS. 3 and 4 that:

[T]he user can power on the terminal 100 by using either the automatic folder switch 180 or the power key 190 in the powered-off state. Also, the control unit 200 controls the first switch 300 closed and the second switch 302 open **in the powered-on state** of the terminal 100. Accordingly, the automatic folder switch and the power key 190 can perform their own functions.

Ko describes operation of the powered-off state in paragraphs [0035]-[0036], wherein automatic folder switch 180 and power key 190 function as alternate switches to power on the terminal 100. Ko describes operation of the powered-on state in paragraph [0038], which states that “the automatic folder switch 180 and the power key 190 perform their own functions **in the powered-on state** of the terminal 100.”

Thus, Applicants respectfully submit that paragraph [0039] of Ko discloses that the terminal keys (i.e., automatic folder switch 180 and power key 190) function only as power switches when the terminal 100 is powered off, and states in contradiction with the rest of the disclosure that “the terminal keys can perform their own functions in the powered-off state of the terminal.” The automatic folder switch 180 and power key 190 function only as power switches when the terminal 100 is powered off, and perform their own functions only in the powered-on state of the terminal. Ko does not provide a teaching by way of paragraph [0039] that the terminal keys can perform functions other than as power switches in the powered-off state of the terminal.

As to Hess, it does not disclose activating the alarm sequence by the push of one or two buttons when the device is either powered on or off. As Ko teaches that the terminal keys function only as power switches when the terminal 100 is powered off, and perform their own functions only in the powered-on state of the terminal, the combination of Ko and Hess would still require the device to be powered on before activating the alarm sequence. Thus, the cited combination of Ko and Hess does not teach or suggest “wherein the device is programmed to effectuate a predetermined communications connection when a user depresses two or more input keys simultaneously and the device effectuates the predetermined communications connection when the wireless telephony device is either powered on or off” as recited in the combination of elements of claim 6. Accordingly, Applicants respectfully submit that the Office Action fails to establish a prima facie case of obviousness with respect to claim 6, and respectfully request that the rejection of claim 6 under 35 U.S.C. §103(a) be withdrawn.

b. Rejection of claims 2-3, 7-8, 11, 14-15, and 21 based on Kennedy, III et al. in view of Hess.

In Section 5 of the Office Action, claims 2-3, 7-8, 11, 14-15, and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy, III et al. (U.S. Patent No. 6,535,743) in view of Hess (U.S. Patent No. 5,777,551). To establish prima facie obviousness of a claimed invention under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the

prior art (see M.P.E.P. § 2143.03). Applicants respectfully submit that the combination of Kennedy, III et al. and Hess does not teach or suggest at least one element of each of claims 2-3, 7-8, 11, 14-15, and 21.

i. Claims 2-3 and 7-8

Applicants respectfully submit that the Office Action fails to establish a prima facie case of obviousness with respect to claim 7 because the combination of Kennedy, III et al. and Hess fails to teach or suggest “wherein the device is programmed to effectuate a predetermined communications connection when a user depresses two or more input keys simultaneously and the device effectuates the predetermined communications connection when the state of the software operating on the device is in either a non-communications mode or a communications mode” as recited in the combination of elements of claim 7.

The Office Action states that:

Kennedy discloses ... a plurality of input keys (i.e., reads on buttons on user interface) (col. 4, lines 12-22), wherein the device is programmed to effectuate a predetermined communications connection (e.g., emergency button and roadside assistance) when the state of the software operating on the device is in either a non-communications mode or a communications mode (i.e., input from mobile user during pre-existing communication and/or otherwise) (col. 13, lines 55-59 and col. 14, line 65 to col. 15, line 11 and col. 26, lines 8-54).

Kennedy, III et al. discloses at col. 26, lines 8-54 that “in some circumstances, NSC 14 receives a priority service message 442 during preexisting communication between mobile unit 12 and NSC 14” and also describes four possible ways of providing an input event to the communication system. Kennedy, III et al., does not, however, teach that the state of software operating on the communications system is in either a non-communications mode or a communications mode when the input event is provided to the communication system, or that

when there is not a preexisting communication between mobile unit 12 and NSC 14, the state of software operating on the communications system is in either a non-communications mode.

As to Hess, it does not disclose activating the alarm sequence by the push of one or two buttons when the state of software operating on the communications system is in either a non-communications mode or a communications mode. Thus, the cited combination of Kennedy, III et al. and Hess does not teach or suggest “wherein the device is programmed to effectuate a predetermined communications connection when a user depresses two or more input keys simultaneously and the device effectuates the predetermined communications connection when the state of the software operating on the device is in either a non-communications mode or a communications mode” as recited in the combination of elements of claim 7.

Accordingly, Applicants respectfully submit that the Office Action fails to establish a prima facie case of obviousness with respect to claim 7, and respectfully request that the rejection of claim 7 under 35 U.S.C. §103(a) be withdrawn. Additionally, claims 2-3 and 8 depend from claim 7 and are thus patentable for at least the same reasons as claim 7. See 35 U.S.C. § 112 ¶ 4. Accordingly, Applicants respectfully request that the rejection of claims 2-3 and 8 under 35 U.S.C. §103(a) be withdrawn as well.

ii. Claims 11, 14, and 15

Applicants respectfully submit that the Office Action fails to establish a prima facie case of obviousness with respect to claim 14 because the combination of Kennedy, III et al. and Hess fails to teach or suggest “wherein the device effectuates the communications channel to the emergency service when the state of any software operating on the device is in either a non-communications mode or a communications mode” as recited in the combination of steps of claim 14.

The Office Action states that:

Kennedy discloses ... a plurality of input keys (i.e., reads on buttons on user interface) (col. 4, lines 12-22), wherein the device is programmed to effectuate a predetermined communications connection (e.g., emergency button and roadside assistance) when the state of the software operating on the device is in either a non-communications mode or a communications mode (i.e., input from mobile user during pre-existing communication and/or otherwise) (col. 13, lines 55-59 and col. 14, line 65 to col. 15, line 11 and col. 26, lines 8-54).

Kennedy, III et al. discloses at col. 26, lines 8-54 that “in some circumstances, NSC 14 receives a priority service message 442 during preexisting communication between mobile unit 12 and NSC 14” and also describes four possible ways of providing an input event to the communication system. Kennedy, III et al., does not, however, teach that the state of software operating on the communications system is in either a non-communications mode or a communications mode when the input event is provided to the communication system, or that when there is not a preexisting communication between mobile unit 12 and NSC 14, the state of software operating on the communications system is in either a non-communications mode.

As to Hess, it does not disclose activating the alarm sequence by the push of one or two buttons when the state of software operating on the communications system is in either a non-communications mode or a communications mode. Thus, the cited combination of Kennedy, III et al. and Hess does not teach or suggest “wherein the device effectuates the communications channel to the emergency service when the state of any software operating on the device is in either a non-communications mode or a communications mode” as recited in the combination of steps of claim 14.

Accordingly, Applicants respectfully submit that the Office Action fails to establish a prima facie case of obviousness with respect to claim 14, and respectfully request that the rejection of claim 14 under 35 U.S.C. §103(a) be withdrawn. Additionally, claims 11 and 15 depend from claim 14 and are thus patentable for at least the same reasons as claim 14. See 35 U.S.C. § 112 ¶ 4. Accordingly, Applicants respectfully request that the rejection of claims 11 and 15 under 35 U.S.C. §103(a) be withdrawn as well.

iii. Claim 21

Applicants respectfully submit that the Office Action fails to establish a prima facie case of obviousness with respect to claim 21 because the combination of Kennedy, III et al. and Hess fails to teach or suggest “wherein the device is configured to effectuate the communications channel to the emergency service when the state of any software operating on the device is in a non-communications mode, and is further configured to effectuate the communications channel to the emergency service when the state of any software operating on the device is in a communications mode” as recited in the combination of elements of claim 21, as amended.

The Office Action states that:

Hess suggests an operating system (i.e., reads on microprocessor) configured to call an emergency service when two user input keys are pressed simultaneously, wherein the device effectuates the communication channel to the emergency service regardless of the state of any software operating on the device (i.e., Examiner interprets the claim language to include the case wherein whatever operating state the device is in when the user depresses said input keys) (col. 3, lines 37-63).

Hess teaches at col. 3, lines 37-63 that “[t]he alarm system is controlled by the microprocessor 20” and that “the interface panel is used to program the alarm system,” and that the alarm system is programmed to “activate the alarm sequence” to place a call. Hess does not teach that the alarm system is configured such that the alarm sequence may be activated if the state of any software operating on the alarm system is in a non-communications mode and is also configured such that the alarm sequence may be activated if the state of any software operating on the alarm system is in a non-communications mode. Thus, the cited combination of Kennedy, III et al. and Hess fails to teach or suggest “wherein the device is configured to effectuate the communications channel to the emergency service when the state of any software operating on the device is in a non-communications mode, and is further configured to effectuate the communications channel to the emergency service when the state of any software operating on the device is in a communications mode” as recited in the combination of elements of claim 21.

Accordingly, Applicants respectfully submit that the Office Action fails to establish a prima facie case of obviousness with respect to claim 21, and respectfully request that the rejection of claim 21 under 35 U.S.C. §103(a) be withdrawn.

c. Rejection of claims 4, 12, and 24 based on Kennedy, III et al. in view of Hess and further in view of Yasuda et al.

In Section 6 of the Office Action, claims 4, 12, and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy, III et al. et al. and Hess in view of Yasuda et al. (U.S. Patent No. 5,901,365). Claim 4 depends from claim 7. Claim 12 depends from claim 14. Claim 24 depends from claim 21. As stated above with regard to claim 7, claim 14, and claim 21, the combination of Kennedy, III et al. and Hess does not disclose or teach the subject matter of claim 7, claim 14, or claim 21. As to Yasuda et al., it does not appear to make up for all of the above-mentioned deficiencies in the combination of Kennedy, III et al. and Hess. Because the cited combination of Kennedy, III et al., Hess and Yasuda et al. does not disclose or teach the subject matter of claim 7, claim 14, or claim 21, Applicants respectfully submit that claim 4, claim 12, and claim 24 are each patentable over the cited combination of Kennedy, III et al., Hess and Yasuda et al. for at least the same reasons as claim 7, claim 14, and claim 21 respectively. See 35 U.S.C. § 112, ¶ 4. Accordingly, the Applicants respectfully request that the rejection of claims 4, 13, and 23 under 35 U.S.C. § 103(a) be withdrawn.

d. Rejection of claims 5, 13, and 23 based on Kennedy, III et al. in view of Hess and further in view of Asari et al.

In Section 7 of the Office Action, claims 5, 13, and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy, III et al. et al. and Hess in view of Asari et al. (U.S. Patent No. 6,031,470). Claim 5 depends from claim 7. Claim 13 depends from claim 14. Claim 23 depends from claim 21. As stated above with regard to claim 7, claim 14, and claim 21, the combination of Kennedy, III et al. and Hess does not disclose or teach the subject matter of claim 7, claim 14, or claim 21. As to Asari et al., it does not appear to make up for all of the above-mentioned deficiencies in the combination of Kennedy, III et al. and Hess. Because the cited

combination of Kennedy, III et al., Hess and Asari et al. does not disclose or teach the subject matter of claim 7, claim 14, or claim 21, Applicants respectfully submit that claim 5, claim 13, and claim 23 are each patentable over the cited combination of Kennedy, III et al., Hess and Asari et al. for at least the same reasons as claim 7, claim 14, and claim 21 respectively. See 35 U.S.C. § 112, ¶ 4. Accordingly, the Applicants respectfully request that the rejection of claims 5, 13, and 23 under 35 U.S.C. § 103(a) be withdrawn.

e. Rejection of claims 10 and 17 based on Kennedy, III et al. in view of Hess and further in view of Kienberger

In Section 8 of the Office Action, claims 10 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy, III et al. et al. and Hess in view of Kienberger (U.S. Patent No. 5,467,387). Claim 10 depends from claim 7. Claim 17 depends from claim 14. As stated above with regard to claim 7 and claim 14, the combination of Kennedy, III et al. and Hess does not disclose or teach the subject matter of claim 7 or claim 14. As to Kienberger, it does not appear to make up for all of the above-mentioned deficiencies in the combination of Kennedy, III et al. and Hess. Because the cited combination of Kennedy, III et al., Hess and Kienberger does not disclose or teach the subject matter of claim 7 or claim 14, Applicants respectfully submit that claim 10 and claim 17 are each patentable over the cited combination of Kennedy, III et al., Hess and Kienberger for at least the same reasons as claim 7 and claim 14 respectively. See 35 U.S.C. § 112, ¶ 4. Accordingly, the Applicants respectfully request that the rejection of claims 10 and 17 under 35 U.S.C. § 103(a) be withdrawn.

f. Rejection of claims 9 and 16 based on Kennedy, III et al. in view of Hess and further in view of Nilsson et al.

In Section 9 of the Office Action, claims 9 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy, III et al. et al. and Hess in view of Nilsson et al. (U.S. Patent No. 6,332,073). Claim 9 depends from claim 7. Claim 16 depends from claim 14. As stated above with regard to claim 7 and claim 14, the combination of Kennedy, III et al. and Hess does not disclose or teach the subject matter of claim 7 or claim 14. As to Nilsson et al., it does not

appear to make up for all of the above-mentioned deficiencies in the combination of Kennedy, III et al. and Hess. Because the cited combination of Kennedy, III et al., Hess and Nilsson et al. does not disclose or teach the subject matter of claim 7 or claim 14, Applicants respectfully submit that claim 9 and claim 16 are each patentable over the cited combination of Kennedy, III et al., Hess and Nilsson et al. for at least the same reasons as claim 7 and claim 14 respectively. See 35 U.S.C. § 112, ¶ 4. Accordingly, the Applicants respectfully request that the rejection of claims 9 and 16 under 35 U.S.C. § 103(a) be withdrawn.

g. Rejection of claim 22 based on Kennedy, III et al. in view of Hess and further in view of Shaanan et al.

In Section 10 of the Office Action, claim 22 is rejected under 35 U.S.C. §103(a) as being unpatentable over Kennedy, III et al. et al. and Hess in view of Shaanan et al. (U.S. Patent No. 6,332,084). Claim 22 depends from claim 21. As stated above with regard to claim 21, the combination of Kennedy, III et al. and Hess does not disclose or teach the subject matter of claim 21. As to Shaanan et al., it does not appear to make up for all of the above-mentioned deficiencies in the combination of Kennedy, III et al. and Hess. Because the cited combination of Kennedy, III et al., Hess and Shaanan et al. does not disclose or teach the subject matter of claim 21, Applicants respectfully submit that claim 22 is patentable over the cited combination of Kennedy, III et al., Hess and Shaanan et al. for at least the same reasons as 21. See 35 U.S.C. § 112, ¶ 4. Accordingly, the Applicants respectfully request that the rejection of claim 21 under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

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